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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,215	02/19/2004	James A. McClain	030900	5338
41835	7590	11/02/2004	EXAMINER	
KIRKPATRICK & LOCKHART LLP HENRY W. OLIVER BUILDING 535 SMITHFIELD STREET PITTSBURG, PA 15222			WARD, PAUL V	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,215

Applicant(s)

MCCLAIN, JAMES A.

Examiner

PAUL V WARD

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 24, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "about the reaction temperature" in the claims is a relative term which renders the claim indefinite. The term "about the reaction temperature" is not defined by the claim, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 13 recites the limitation "the moisture content". There is insufficient antecedent basis for this limitation in the claim.

Claim 14 is indefinite because it is unclear whether the moisture content is reduced between 2-6% when the moisture content was originally 2-6%.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohkuma et al. (U.S. Patent 5,358,729).

Applicant claims a method for producing resistant starch by (1) selecting a reaction temperature, (2) acidifying the starch, (3) heating the acidified starch to the reaction temperature, and (4) maintaining the acidified starch close to the reaction temperature to maintain a "whiteness" level. Applicant further limits the method by using a starch having a moisture content between 2-6%, by using HCl to acidify the starch to a pH between 1-4, having a 60% recovery of the resistant starch, having a reaction temperature between 140-160 C, and having a whiteness level between 50-100.

Ohkuma teaches a method for producing a resistance starch by (1) selecting a reaction temperature, (2) acidifying the starch, (3) heating the acidified starch to the reaction temperature, and (4) maintaining the acidified starch close to the reaction temperature to avoid coloring. (See Abstract and col. 1, lines 6-10). In column 6, line 41, Ohkuma teaches that HCl is used to acidify the starch. Additionally, in column 23, line 37, Ohkuma emphasizes that the whiteness decreased in inverse proportion to the heating temperature or heating time, and figures 2 and 3 demonstrate, from a comparative analysis, that the degree of coloration at pH 4.5 is lower than the degree in a reaction at pH 6.5. Further, in Table 13, Ohkuma discloses a whiteness level ranging from 12.3 to 66. (See also Example 4). Still further, Ohkuma states, in column 6, line 66, that the reaction temperature is 120-200 C, and "more preferably 140-180 C", and in Example 5, column 31, Ohkuma employs a starch having a moisture content of 5%. Moreover, Ohkuma teaches that the resistant starch recovered is in an increased amount of at least 60%. (See column 5, line 7-10).

It is noted that applicants are claiming a product by a process in Claim 27. The process of making has no patentable import on the product as claimed. Products are treated on the merits of the products themselves, and not on the process of making the same. There is not seen to be any patentable difference between the product as claimed in the instant application, and the products of the prior art. See In re Thorpe, 227 U.S.P.Q. 964, 966 (Fed. Cir. 1965).

Since Ohkuma teaches the same method for producing resistant starch, Applicant claims are anticipated, and thus, rejected under 35 U.S.C. 102(b).

Conclusion

Claims 1-27 are pending. Claims 1-27 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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